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10/710,293

06/30/2004

Deborra J. Zukowski

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EXAMINER

ULRICH, NICHOLAS S

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/710,293	<b>Applicant(s)</b> ZUKOWSKI ET AL.	
	<b>Examiner</b> NICHOLAS S. ULRICH	<b>Art Unit</b> 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,7,9-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,7 and 9 is/are rejected.
- 7) ☐ Claim(s) 4,5,10-16 and 18-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/03/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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1. Claims 1, 4, 5, 7, 9-16, and 18-20 are pending.
2. Claims 1, 4, 7, and 9 are amended.
3. The IDS filed 12/03/2008 is considered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites "update from a first configuration to a second configuration" and "to reach the second configuration". The claims language used in this instance is not consistent with the present disclosure. It is evident from the disclosure in paragraph 0046 lines 1-4, that the change of state triggers a type of function/activity. There is no mention of changing from one configuration to another configuration in the present disclosure. The examiner recommends removing any instances in the claims involving the first and second configurations.

Claim 1 goes on further to state "then executing a response to reach the second configuration suing the determined type of response by launching an application using

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the revised needed inputs". "Executing a response" is not mentioned in the specification. As best understood by the examiner, this limitation is relating to Fig 6 elements 640 and 650 and Paragraphs 58-59. The examiner recommends including the subject matter discussed in these passages to clearly define the invention. The user has the ability to accept or reject the notification. If the user provides application parameters and accepts the notification then an application/function is started using the parameters. The examiner suggests removing the limitation "then executing a response to reach the second configuration using the determined type of response by launching an application using the revised needed inputs" with "launching an application using the revised needed inputs when the user accepts the notification" in order to overcome the current 112 rejection.

5. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 7 recites "changing the environments context in response to the selection". The specification in paragraph 54 clearly defines that the selection of the notification **may** cause the environment to change context. This is not consistent with the claim language. As currently claimed, any time the user selects a notification, the environment context is changed. To include this limitation in the claims, the examiner recommends incorporating the subject matter of Fig 6 element 610, the step of reporting

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to the responsive environment that the notification has been selected, which may cause the change in context. Further, the examiner recommends including the subject matter of claim 1, "launching an application using the revised needed inputs".

6. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 9 recites "wherein changing the environment context in response to the selection comprises notifying an initiator of an initial message". As indicated above, the specification does not teach "changing the environments context in response to the selection". In paragraph 0054, the specification teaches that an initiator of an initial message is notified when the user selects the notification. The examiner recommends claim 9 to recite " wherein reporting to the responsive environment that the user has selected a response notification comprises: notifying an initiator", in order to overcome the current 112 rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission

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amounting to a gap between the necessary structural connections. See MPEP

§ 2172.01. The omitted structural cooperative relationships are: The association of the “new notification” with “the new notification description”. It is evident from the disclosure in paragraph 0046 lines 6-14, that the created notification includes the notification description and response descriptions. This must be reflected in the claims. The language of the claims should indicate that the new notification includes this structural connection. The examiner recommends including the limitation "creating a new notification comprising the new notification description" in order to overcome the current 112 rejection.

8. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: “wherein the at least one user response includes revised needed inputs”. The current claim recites "revised application parameter data received from the user in response to the query". However, the claim never makes mention as to when the user provides the revised application parameter data. In order to overcome this current 112 rejection the examiner recommends including the subject matter stated in independent claim 1, “wherein the at least one user response includes revised needed inputs”.

***Claim Objections***

9. Claim 1 is objected to because of the following informalities: The use of the word “suing” is not consistent with the invention. The use of the word “suing” does not seem to relate in any way to the claimed invention. This may be a typo and meant to say “issuing”. Appropriate correction is required.

10. Claim 7 is objected to because of the following informalities: ‘URI’ should be spelled out in its entirety.

***Allowable Subject Matter***

11. Claims 1, 7, and 9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 1 recites "receive at least one response to the plurality of the new notification from the user", wherein the at least one user response includes revised needed inputs", and "launching an application using the revised needed inputs".

Claim 7 recites “revised application parameter data received from the user in response to the query”.

Watts et al. (US 6119186) clearly teaches a responsive environment system with delayed activation. Watts’s method for delaying the activation includes prompting the user for acceptance of a notification before updating the responsive environment. However, Watts does not mention allowing the user to update application parameters or

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needed inputs for an application within the notification and then launching the application with revised application parameters or revised needed inputs.

12. Claims 4, 5, 10-16, 18, 19, and 20 objected to as being dependent upon a rejected base claim.

13. Indicated above is a plurality of 112 issues associated with the claims 1 and 7. The examiner has attempted to provide an indication to all of the errors with the claims in order to provide applicant with the necessary changes required in order to place this application in condition for allowance. However, the examiner believes the claims to be replete with errors and 112 issues and recommend to the applicant to review each claim in detail and possibly rework the claims to better define what they believe the invention to be based the present specification and to also include the indicated allowable subject matter. The claims can not be allowed until they are consistent with that which is described in the specification and clearly recite what the invention is.

### ***Response to Arguments***

14. Applicant's arguments, see Remarks, filed 9/04/2008, with respect to Rejection under 35 USC 103(a) have been fully considered and are persuasive. The 35 USC 103(a) rejections of claims 1, 4, 5, 7, 9-16, and 18-20 have been withdrawn. However, based upon a further review of the present claims, a number of 112 issues have been indicated that must be corrected in order to place this application in condition for



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allowance. See rejection listed above. Currently claims 1, 7, and 9 are rejected under 35 USC 112 and all dependent claims are objected to for being dependent on rejected claims 1 and 7.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICHOLAS S. ULRICH whose telephone number is (571)270-1397. The examiner can normally be reached on M-TH 9:00 - 5:00 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571)272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tadesse Hailu/  
Primary Examiner, Art Unit 2173

Nicholas Ulrich  
12/15/2008  
2173